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### REMARKS

Pending claims are directed to a method of controlled release of NO or an NO donor at a tissue and to a method of reducing the formation of surgical adhesions through controlled release of NO or an NO donor. The claimed methods comprise a step of administering a biocompatible, polymerizable, macromer composition containing at least one NO carrying region or an NO donor. Claims 18, 20, 21 and 32-46 are pending. Claims 18 and 20 have been amended. Amendments do not add any new matter.

#### Telephone Interview

Applicants thank the Examiner for the courtesy of Telephone Interviews on March 12, and March 13, 2007, during which potential claim amendments were discussed.

#### Claim Rejections under 35 U.S.C. §112, First Paragraph

In the Office Action mailed September 13, 2006, the Examiner rejected Claims 18, 20, 21 and 32-46 under 35 U.S.C. §112, first paragraph, for insufficient enablement. The rejection concerns the term "NO modulating compound" recited in the claims. Examiner asserted that one of ordinary skill in the art was unable to fully predict possible result from the administration of the compounds due to the unpredictability of the role of NO donor and diseases treatable by NO donor. Applicants respectfully traverse the rejection.

The Examiner cited Lin *et al.*, *Expert Opinion on Therapeutic Patents*, v. 15, pp. 483-495 (2005) as evidence in support of the rejection. In particular, the Examiner cited

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a statement on p. 487, second full paragraph, in Lin *et al.*, that systemic administration of NO donor was impractical. Applicants respectfully bring to the Examiner's attention that, in the same paragraph, Lin *et al.* stated: "Local delivery of NO donors ... appears to be the approach of choice to minimize ... the problem and risks associated with systemic NO/NO donor administration." Applicants' claimed method is such a method of targeted, controlled delivery of NO or NO donor to tissues that Lin *et al.* described as "the approach of choice." Applicants assert that the specification, as filed, describes the claimed subject matter in such a way as to enable one of ordinary skill in the art in the field of NO delivery to make and use the claimed invention.

For clarity, Applicants amended independent Claims 18 and 20 to recite "NO donor." Support for the amendment is found, for example, on p. 13, line 21 of the specification, where it uses the term "NO donors." Examples of various NO donors known to those of ordinary skill in the art are listed on p. 13, lines 20-32 of the specification. Applicants assert that, based on the specification and to knowledge available to one of ordinary skill in the art in the field of NO delivery at the priority date of the present application, one of ordinary skill in the art in the field of the invention would have been able to use NO donors, complex them to the polymerizable composition recited in the claims, and use the resulting compositions for controlled delivery of NO or NO donors to tissues as recited in Claim 18. Applicants also assert that one of ordinary skill in the art would have been able to use the resulting polymerizable compositions for controlled delivery of NO donors to tissues in order to reduce surgical adhesions, as recited in Claim 20.

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The Examiner asserted that the *in vitro* working examples provided by Applicants did not enable one of ordinary skill in the art in the field of the present application to use the claimed invention. Applicants disagree. An *in vitro* example in the specification constitutes a working example for the purpose of enablement if that example correlates with the claimed invention. The Examiner must give reasons for a conclusion of lack of correlation. A rigorous or an invariable exact correlation is not required. See MPEP 2164.02. The Examiner did not provide evidence for lack of correlation between *in vitro* examples provided in the specification and the claimed invention.

Applicants respectfully assert that one of ordinary skill in the art in the field of NO delivery would consider a combination of the *in vitro* working examples describing the use of the polymerizable compositions recited in the claims for NO delivery, for example, on p. 22-25 of the specification, with the disclosure of NO donors provided on p. 13, as reasonably correlating with the scope of Applicants' claimed method of controlled release of NO or an NO donor (independent Claim 18) and of reducing the formation of surgical adhesions through controlled release of NO or an NO donor (independent Claim 20). In view of the foregoing, Applicants respectfully assert that the claims are enabled and request withdrawal of the rejection of Claims 18, 20, 21 and 32-46 under 35 U.S.C. §112, first paragraph.

Claim Rejections under 35 U.S.C. §112, Second Paragraph - Indefiniteness

The Examiner rejected Claims 18 and 32-46 as indefinite under 35 U.S.C. §112, second paragraph. Applicants respectfully assert that the amendments submitted in

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this Response clarify the claims and overcome the rejection. Applicants request withdrawal of the rejection.

Claim Rejections under 35 U.S.C. §112, First Paragraph – New Matter

The Examiner rejects Claims 18, 20, 21 and 32-46 under 35 U.S.C. § 112, first paragraph, for reasons of insufficient written description. The Examiner asserts that the specification does not support the language “wherein NO modulating compound is complexed to the macromer composition,” which was introduced into the claims by an earlier amendment. Currently amended claims recite the language “wherein NO or the NO donor is complexed to the macromer composition.” Support for the claim language appears, for example, on page 13, lines 30-32 of the specification, where it states (emphasis added):

The molecules which produce NO, or release or generate NO, are preferably attached to regions containing nucleophiles and/or thiols, such as S-nitrosothiols capable of **forming a complex with NO.**

Applicants therefore assert that Claims 18, 20, 21 and 32-46 are supported by the specification, as filed, and request withdrawal of the rejection under 35 U.S.C. § 112, first paragraph, for reasons of insufficient written description.

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Non-Statutory Double Patenting Rejection

The Examiner provisionally rejected Claims 18, 20, 21 and 32-44 under the judicially created doctrine of obviousness-type double patenting as unpatentable over Claims 1-18 of commonly owned U.S. Patent No. 7,052,711. Applicants provide herein an appropriate terminal disclaimer, assert that the rejection has been overcome and request its withdrawal.

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### CONCLUSION

The foregoing is submitted as a full and complete response to the Office Action mailed September 13, 2006. Applicants submit that the claims are now in condition for allowance and respectfully request that the application be passed to issuance. If the Examiner believes that any informalities remain in the case, which may be corrected by Examiner's amendment, or that there are any other issues that can be resolved by a telephone interview, a telephone call to the undersigned agent at (404) 815-6102 is respectfully solicited.

The Commissioner is hereby authorized to charge any deficiencies which may be required or credit any overpayment to Deposit Account Number 11-0855.

Respectfully submitted,



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